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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

REPLY BRIEF

Inventor : Tracy A. Mahnken
Serial No. : 09/843,904
Filing Date : April 27, 2001
Title : SYSTEM AND METHOD FOR ONLINE LEASING

Group/Art Unit : 3691
Confirmation No. : 9924
Examiner : Olabode Akintola

Docket No. : 773919-0500

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

In accordance with the provisions of 37 C.F.R. § 41.41, Appellant submits this
Reply Brief in response to the Examiner's Answer mailed on March 19, 2008.

REMARKS

In the Examiner's Answer responding to Appellant's Appeal Brief, the examiner maintains his rejection of pending claims 1-24. Appellant first refers the Board to the previously filed Appeal Brief for a detailed response to the Examiner's rejection of the claims. This Reply Brief will directly address the points raised in the Examiner's Answer.

As discussed in detail in Appellant's Appeal Brief, the present application is directed to a system and method in which an online lease agreement can be accepted over a

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computer network such that the parties can avoid the exchange of paperwork and associated quest for signature documents as was previously required in a lease negotiation and agreement process.

Independent claim 1 of the present application requires “a leasing module configured to provide a lease agreement and receive acceptance of the lease agreement over the computer network”, independent claim 19 requires “receiving from the first party acceptance of the lease agreement over the computer network”, and independent claim 24 requires “receiving from the first party over the computer network acceptance of the lease agreement.” Thus, every claim of the present application requires that acceptance of the lease agreement take place over the computer network.

As detailed in Appellant’s Appeal Brief, none of the references cited by the examiner disclose acceptance of the lease agreement over a computer network. Thus, even if the references were combined as suggested by the examiner, they would not teach the invention claimed in the present application.

Foremost, the *Weatherly* reference discloses a computer driven system that is applicable “**once the agreements have been executed** and the accounts set up” (Col. 8, lines 1-4 of *Weatherly*, emphasis added). Furthermore, the flow diagram of FIG. 1 of *Weatherly* indicates that the system generates printed, physical pages (e.g., lease document 32 of FIG. 1), with no indication that acceptance occurs over the computer network, as required and claimed in the present application. Similarly, the *Donahue* reference ultimately requires that original signature documents be printed and sent to the appropriate parties via “email, fax, or express mail” for “obtaining the actual signatures” (col. 16, lines 5-15).

In the Examiner's Reply, the examiner does not refute or address the majority of Appellant's arguments presented in the Appeal Brief, and for the most part simply reiterates the rejections made in the Final Office Action. The only counter-argument to Appellant's Appeal Brief is a single paragraph in which the examiner points out that an opening sentence of the *Donahue* reference states "the invention provides a method and apparatus for allowing two parties to negotiate and execute a real estate lease over a computer network." The examiner then concludes (from this single sentence) that *Donahue* teaches "acceptance" of a lease as that term is used in the claims of the present application, and thus *Donahue* discloses that limitation.

The Examiner's argument is less than compelling, and selective quotation from *Donahue*, presented out-of-context, is misleading. As is immediately apparent upon reading the *Donahue* reference, *Donahue* uses the term "executed" primarily in reference to the performance of specific, pre-defined steps of the method disclosed therein – i.e., the steps of the method are executed in the course of negotiating the lease:

- In the Abstract – "A series of predefined milestone negotiation steps are executed on a computer that couples two parties through a network, such as the Internet."
- In the Summary of Invention – "According to one variation of the method, a series of predefined milestone negotiation steps are executed on a computer that couples two parties through a network, such as the Internet."
- Column 11, lines 47-58 – "The steps need not be executed in sequential order as illustrated in FIG. 3."

The only other use of the term "executed" in *Donahue* is in reference to obtaining signatures on physical, printed documents:

- Column 15, lines 52-65 – "The result of the fifth phase is a lease that the parties agree on (but which has not yet been executed).
- Column 15, line 66 – column 16, line 18 – "The sixth phase (obtain approvals and execute documents) will be explained with reference to FIG. 8. In step 801,

information summaries are prepared. If a corporate approval summary is required, a standard corporate approvals form is generated using information from the lease database. If a financial analysis is required, a standard financial analysis form is generated. In step 802, corporate approvals are obtained by each party. This includes steps of submitting the forms and information for internal approvals, obtaining signatures of local subsidiaries if required; and obtaining management signatures on the approval forms. In step 803, the legal documents are executed. This may include steps of identifying authorized signatories; transmitting original signature documents by e-mail, fax or express mail, and obtaining the actual signatures. In step 804, the parties exchange documents, pay required deposits, and exchange keys or other entrance mechanisms (security codes, etc.) The outcome of this phase is that all legal documents are executed and access is granted to the premises.

As can be seen, *Donahue* uses the term “executed” only in the contexts of (1) performing steps of the lease negotiation process, and (2) signing the physical, printed lease documents - apart from the computerized process. Thus, the examiner’s out-of-context citation of a single-sentence as the basis for stating that *Donahue* discloses online “acceptance” is inaccurate and misleading, at best.

In fact, as seen above and as detailed in Appellant’s Appeal Brief, *Donahue* does not disclose online acceptance as required in all claims of the present application. Likewise, neither *Weatherly* nor *Walker* make such a disclosure.

* * *

For the foregoing reasons, and the reasons set forth in Appellant’s Appeal Brief, Appellant submits that independent claims 1, 19, and 24 (and thus dependent claims 2-18 and 20-23) are patentable over the cited reference and should be allowed. Accordingly, Appellant respectfully requests that the Board reverse the Examiner’s rejections and allow claims 1-24 of the present application.

Respectfully submitted,

By: 

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